IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Walter Fix et al.
SERIAL NO:	10/569,763
FILED:	July 24, 2006
EXAMINER	Joannie A Garcia Art Unit: 2823
FOR:	ORGANIC ELECTRONIC COMPONENT WITH HIGH RESOLUTION STRUCTURING, AND METHOD OF THE PRODUCTION THEREOF
ATTY DKT NO.:	411000-146 Customer no. 27162

PETITION UNDER 37 CFR 1.181

MS AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

This is a petition to withdraw an Advisory Action, and enter proposed amended claims 1 and 5 after a final rejection. The claims were previously submitted in a purported response filed May 14, 2008 in response to a final Office Action dated April 15, 2008. These amended claim are refused entry in an Advisory Action dated June 11, 2008.

Applicants seek the supervisory authority of the Commissioner to reverse the conclusions of the Examiner in the Advisory Action and enter the proposed claims and corresponding arguments as proper under 37 CFR 1.116. Further, applicants request either a new Action or a Notice of Allowance as the cited reference is irrelevant to the claims, prior or subsequent to the proposed amendments thereto

The proposed amendments were submitted in connection with requesting a telephone interview with the examiner after submitting the proposed amended claims, which were submitted for purposes of discussion with the Examiner. The under signed called the examiner a number of times including June 13, 2008 and prior times. The examiner did not return the undersigned's calls. Applicant had initially spoken to the

examiner and to her supervisor Mr. Smith Mathew Smith, with no agreement reached. At that time, Ms. Garcia advised the undersigned she could not make an examiner's amendment after final.

In response, applicants' undersigned attorney faxed the enclosed facsimile document dated May 7, 2008 enclosing a copy of the MPEP, 706.07(f)II and MPEP 707.07(j)II. MPEP 706.07(f) II expressly permits the examiner to enter an examiner's amendment after a final rejection contrary to Ms. Garcia's statement to the undersigned to the contrary. There was no further response to this fax to the undersigned outside the Advisory Action and certainly no attempt to reach the undersigned to arrange the prior requested telephone interview.

The PTO complains that it is overloaded, and in response , proposed new onerous rules, which have been enjoined. Perhaps, the overload to the PTO work load is of its own making in view of the facts of the instant case and other similar cases where examiners typically pro forma refuse to enter a proposed amendment simply because there is a final Action. The MPEP cited above expressly permits examiners to enter after final proposed amendments if they put the application in condition for allowance even though a new limitation is added. The typical examiner cliché response is that any new limitation must per se require a new search. This is not always true as the initial search must include a search of the invention as a whole as disclosed and as would be determined by the use of common sense and not blind adherence to strict rules as was done in the instant application and in other situations.

The advisory requests support for the added term "electrically insulating" substrate. The term "electrically insulating" is inherent in the disclosure and in the claim. Applicants do not have to show the express language "electrically insulating" in their specification, because it is inherent and well understood technology as understood by those of skill in this art as discussed below.

Reference is made to MPEP 2163.07(a). "Inherent Function, Theory, or Advantage" copy attached:

> "By disclosing . . . a device, that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function theory, or advantage without introducing prohibited new matter."

A conductor track or electrode is merely the equivalent of a wire. Printed circuit boards commonly use such conductor tracks and electrodes, for example, metal pads, to which terminals or leads of electrical devices are soldered etc. These are merely printed circuit electrically conductive paths or conductors that are used to interconnect various electrical or electronic components attached to the printed circuit board (the substrate).

Printed circuit boards, or their equivalents in integrated circuits, comprising silicone or other materials, comprise circuit boards which are notoriously well known to be electrical insulators, typically fiberglass or plastic or some combination of electrically insulating material(s). If the substrate or board were not an insulator the conductive elements, conductors or electrodes, and thus the components, attached to the board would be short circuited and the circuit would not function. Circuit boards comprise old and well known technology in the electronic printed circuit and integrated circuit structure art.

Applicants' original claims did not call for the substrate to be an electrical insulator as this is inherent and well known technology. The claims previously called for a conductor track or electrode in the depression to be formed by filling the depression with a conductive material (electrically conductive is all that must have been intended by the disclosure and context). Common sense teaches that to have a conductor track or electrode in a substrate depression, the depression must be

formed in an electrically insulating substrate or else the conductor or electrode would not function as such and would be irrelevant. An electrically conductive substrate such as a metal sheet as in the reference to Yamamoto would short circuit such conductor tracks or electrodes. It is well known that electrically conductive wires are encased in electrically insulating jackets. This is inherent.

The fact that the claims did not originally call for the substrate to be an electrical insulator and asserting that adding this subject matter later is new matter is unreasonable as to how one of ordinary skill would construe the claims. The requirement to show support does not recognize that such support can be and in fact is inherent. Claims are directed to persons of ordinary skill and they would not put a conductor track or electrode in a depression in a metal substrate as in Yamamoto. This is not common sense.

The cited reference to Yamamoto is irrelevant to the claims as discussed and it is unusual for the PTO to take the present case to a final rejection based on this reference, which has nothing to do with the claimed subject matter. The examiner's refusal to consider the arguments, the proposed amendments, applicants' disclosure, applicant's undersigned attorney's calls intending to arrange a telephone interview and the cited MPEP shows a disregard of the spirit and intent of the MPEP and its direction to the examiner.

The Advisory Action states that the proposed amendments change the scope of claims 1 and 5, raise new issues requiring further consideration and/or search. It further states that applicants have not pointed to support in the original disclosure. Applicants disagree as to these conclusions as not based on law or the MPEP and current USPTO procedures as set forth in the MPEP cited above.

The proposed amended claims 1 and 5 are as follows:

1 (Currently amended). An electronic component made from primarily organic material, comprising:

[[a]] an electrically insulating substrate and/or lower layer having a depression formed by a laser; and

at least one electrical conductor track and/or electrode in the depression, the depression having steep walls, sharp contours and a relatively rough bottom surface, the at least one conductor track ~~and/or electrode~~ comprising at least one electrically conductive material for interconnecting electrical components on the substrate .

5 (Currently amended). A method for producing an organic electronic component with a conductor track or electrode, the component having [[a]] an insulating lower layer and/or a substrate, the method comprising treating the lower layer and/or substrate with a laser such that at least one depression and/or one modified region are formed in the lower layer and/or the substrate, then filling the depression and/or modified region with an electrically conductive material to thereby produce the conductor track and/or electrode from the electrically conductive material.

The remaining claims are dependent on these claims. The claims thus are directed to an insulated substrate and creating a conductor track depression in the substrate with a laser which forms the depression with certain claimed characteristic features which applicants believe are novel and not disclosed by the cited reference, and which depression is filled with a conductive material which in essence forms the conductor track.

Applicants argued in their so called response as follows:

The Yamamoto reference structure does not disclose a laser formed depression as in both claims 1 and 5 or with steep side walls and sharp contours as

in claim 1. The so called depressions in this reference, the hills and valleys shown in the figures, are preformed in the substrate as a roughened matte material by the electro-deposition process forming the copper foil substrate. See the ref. [0022] line 3 and [0029].

> [0029] "By changing the roughness of the initial surface of a copper foil, it is made possible to keep the reflectance of the initial radiation face . . . has the intrinsic roughness which the matte side of a copper foil has or a prescribed roughness and the surface having a prescribed roughness . . . laser processing becomes difficult for a copper foil layer in a prescribed depth."(underlining added)

The problem addressed in this reference is how to drill holes in a highly reflective copper foil substrate. The substrate reflected the laser beam thus precluding the beam from forming the desired holes. The solution to the problem was to coat the foil with an antireflective coating which comprises metal particles as disclosed and shown in the various figures. The coating reduced the reflectivity of the surface of the coated foil permitting the laser beam to produce the desired holes.

Holes are not depressions. Even if the holes were filled with a conductive material, since the holes are formed in a metal substrate the holes could not form a conductive electrode as they would be short circuited by the substrate and such electrodes would be meaningless in such a structure.

In the reference [0048], "The roughness formed in the matte side of an electrodeposited copper foil is as shown in Fig. 6 is a hill-like convexoconcave shape and an additional metal layer is to be formed on the surface of the hill-like shape." (underlining added) This hill-like shape is the initial surface roughness of the electrodeposited copper foil and is not formed by a laser as assumed erroneously by the Action.

The description refers to a "matte side" and "roughness of the initial surface" such that the reference specification is thus referring to the undulations or hills and

valleys at the so called "matte side 8", Fig. 1. The copper particles 9 are thus deposited to make the surface more receptive to a laser beam for forming a hole through the substrate and are irrelevant to forming a conductor track. (which they can not do since the substrate is metal as discussed above).

See the ref. [0024] "the surface treated copper foil is a surface treated copper foil for laser hole formation." See [0008] discussing the problem of hole formation in the disclosed substrate with a laser which "becomes more difficult." The "copper foil reflects the laser" and the "drilling speed is retarded." [0009].

This reference deals with the problem of forming holes with a laser in a copper foil substrate and not in forming a conductor track in a depression formed by a laser as claimed, and does not disclose the characteristics of the surface of the depression as in claim 1. There is no insulator with such a laser formed depression. The Action is in error and the proposed amendment should have been entered as the conclusions of the Action are in error and this Action should be withdrawn. No such claimed depression formed by a laser is disclosed in this reference. The entire disclosure of this reference is about forming holes in such a foil. See [0030] "To carry out hole formation processing of copper by laser processing . . ." and numerous other sections of the reference.

Thus, there is no laser formed depression in an insulating substrate suggested or disclosed in this reference and there is no electrically conductive conductor track in the depression since the substrate is metal and electrically conductive. There is no insulating substrate as claimed disclosed in this reference formed as claimed.

In applicants' disclosure an electrical conductor track is an electrically conductive path that conducts electrons. It is plain, that the substrate can not also be an electrical conductor, i.e., It must be an electrical insulator, otherwise, the track in the substrate could not function as an electrical path as intended. The path is for

electrically interconnecting various electrical components on the substrate. This would be so understood by one of ordinary skill. As stated at page 2, lines 15-22, the component including the substrate is primarily organic material. Organic material are polymers, i.e., plastics which are electrical insulators.

The electrically conductive material is described at page 5, first and second paragraphs. In the paragraph at lines 16-18, PANI, PEDOT are described as organic conductive materials. The conductors are built, according to one embodiment of the invention, wherein the second layer adapts the work function of the respective metallic conductive layer and the active organic semiconductor layer.

At page 6, lines 11-15, the specification states "Thereafter, the superfluous material is removed and preferably sharply delineated regions in which conductive material is introduced and/or applied are formed together with others, which are free from conductive material (See Fig. A4)" (underlining added) One of ordinary skill would understand that the material indicated to "be free from conductive material" is an electrical insulator.

See also page 8, lines 8-26 for a description of organic materials. This definition is generally for the term organic, if conductive, insulating or semiconductor. One of ordinary skill in view of the specification would understand that the disclosure is directed to an electrically insulating substrate as described throughout the disclosure. For example, in the figure B4, a two layer electrically conductive pair of layers, one of them being metallic, the other being for example PANI, are in the depression as described in the text at page 6, lines 17-32. A highly conductive layer x (black) and a conductive polymer layer y (grey) is in the depression, Fig. 2, B6. The layer y could be PANI or PEDOT.

It would be so understood by one of ordinary skill in order for the layers x and y to form electrodes and conductive tracks, the substrate (the clear unshaded region

in Fig. 2 B6) in which the tracks are formed must be the electrical insulation material "free from conductive material." If this substrate were not an electrical insulator, i.e., a metal for example, then obviously the entire structure would be an electrical conductor as metals are well known electrical conductors and the so call conductor tracks would be meaningless.

The specification at page 3, lines 10-12, further states that "leakage currents between the conductor tracks and/or electrodes are avoided." Plainly, if the substrate were a metal electrical conductor and not an electrical insulator as in the reference, this statement would not make sense as there would much more than mere leakage currents, there will be a short circuit between the conductor tracks. The specification is construed by and directed to one of ordinary skill. Such a person would so understand the disclosure as described above as being directed to conductor tracks or electrodes formed in an electrically insulating substrate. Otherwise such a structure would be inoperative.

In view of the claim 1 structure, claim 1, as amended, is not suggested or anticipated by Yamamoto, since this reference throughout its disclosure discloses the substrate as being a metal. Thus the depressions and copper particles deposited therein and therebetween can not and do not form electrodes or conductor tracks as claimed, which would be short circuited and inoperative. The substrate in all of the reference figures is a metal.

In Figs. 1 and 8 of the reference, the copper particles 9 are not in the depressions as claimed, but on the peaks between the depressions. These could not possibly form the claimed conductor tracks or electrodes, since they are also deposited on a metal foil substrate.

The reference Fig. 4 shows the copper particles on a flat surface of a metal foil 3. The so called rough surface on the upper opposite side is an additional metal layer on a foil and do not form such claimed tracks or electrodes.

The reference Fig. 11 shows copper particles in the grooves and peaks forming a continuous layer which is contradictory to forming a conductor track. The entire structure is metal and different than what is claimed in claim 1. The remaining figures are equally foreign to claim 1. This reference is so foreign to claim 1 that further comment is not seen necessary. The remaining references cited of record are believed equally foreign to claim 1.

This claim is believed allowable, with or without the term electrically insulating substrate added.

Applicants respectfully request that the Advisory Action be withdrawn, the proposed amended claims and corresponding arguments entered and either the final Action withdrawn and a new Action with a new reference provided or the application allowed. This is the appropriate results to which this petition is directed.

While no fee is believed due for this paper, the Commissioner is authorized to charge any fee that might be due or credit any overpayment to deposit account 03 0678.

Respectfully submitted,
Walter Fix et al.

June 23, 2008

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TIME COMPLETED:

EXT. NO.: 524

DATE: 5/7/2008 **OUR FILE NO.:** 411000-146

US Patent application: s/n10569763 Walter Fix et al. **Your file:**

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FROM: **Total Pages Including Transmittal Sheet:** 3

William Squire Reg. 25378

See attached MPEP 707.07(f) II "Examiner's Amendments" & MPEP 707.07(j) II "Allowable Except as to Form" wherein allowable subject matter should be recognized by the Examiner and suggested where applicable by Examiner's amendment, an examiner's amendment may be made after final rejection, MPEP 706.07(f) II and my call of 4/23/08 re proposed amended claim 1 to add that the substrate is an insulator. See applicants' Fig. 2 B6 and Fig. 3 C5. Figs. A2, B2, C2 which show laser formed depression in substrate (clear). Conductive material X (grey shading) and Y (black shading) is shown in depression Figs. B6 and C5. Substrate must be an insulator and thus can not be electrically conductive or else no conductive track can be formed in the depression. If the substrate is metal as in Yamamoto, then the substrate would short circuit the track. See Applicants' Spec. page 7, lines 20-24. The Action is in error. The so called Yamamoto depressions are a preformed roughened surface or matte finish and are not formed by a laser. The laser is used to form holes and not depressions. Holes and depressions are not the same. The so called depressions of Yamamoto are trough triangular shaped. Applicants refer to prior art with similar trough structures in DE 10061297.0, applicants' spec. page 1, lines 31-39. These rounded troughs do not work to form conductor tracks. The steep walls, sharp contours of claim 1 are not shown by Yamamoto whose troughs are smooth and rounded and not formed by a laser. Claim 1 is not shown or suggested by Yamamoto.

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II. EXAMINER'S AMENDMENTS

(F) Where a complete first reply to a final Office action has been filed within 2 months of the final Office action, an examiner's amendment to place the application in condition for allowance may be made without the payment of extension fees even if the examiner's amendment is made more than 3 months from the date of the final Office action. Note that an examiner's amendment may not be made more than 6 months from the date of the final Office action, as the application would be abandoned at that point by operation of law.

(G) Where a complete first reply to a final Office action has not been filed within 2 months of the final Office action, applicant's authorization to make an amendment to place the application in condition for allowance must be made either within the 3 month shortened statutory period or within an extended period for reply that has been petitioned and paid for by applicant pursuant to 37 CFR 1.136(a). However, an examiner's amendment correcting only formal matters which are identified for the first time after a reply is made to a final Office action would not require any extension fee, since the reply to the final Office action put the application in condition for allowance except for the correction of formal matters, the correction of which had not yet been required by the examiner.

(H) An extension of time under 37 CFR 1.136(a) requires a petition for an extension and the appropriate fee provided for in 37 CFR 1.17. Where an extension of time is necessary to place an application in condition for allowance (e.g., when an examiner's amendment is necessary after the shortened statutory period for reply has expired), applicant may file the required petition and fee or give authorization to the examiner to make the petition of record and charge a specified fee to a deposit account. Office employees may not accept oral (telephonic) instructions to complete the Credit Card Payment Form or otherwise charge a patent process fee (as opposed to information product or service fees) to a credit card. When authorization to make a petition for an extension of time of record is given to the examiner, the authorization must be given before the extended period expires. The authorization must be made of record in an examiner's amendment by indicating the name of the person making the authorization, when the authorization was given, the deposit account number to be charged, the length of the extension requested and the amount of the fee to be charged to the deposit account. Form Paragraph 13.02.02 should be used.

¶ *13.02.02 Extension of Time and Examiner's Amendment Authorized by Telephone*

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on **[1]**, **[2]** requested an extension of time for **[3]** MONTH(S) and authorized the Director to charge Deposit Account No. **[4]** the required fee of $ **[5]** for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Examiner Note:

See MPEP § 706.07(f) which explains when an extension of time is needed in order to make amendments to place the application in condition for allowance.

III. PRACTICE AFTER FINAL

(I) Replies after final should be processed and considered promptly by all Office personnel.

(J) Replies after final should not be considered by the examiner unless they are filed within the SSP or are accompanied by a petition for an extension of time and the appropriate fee (37 CFR 1.17 and 37 CFR 1.136(a)). See also MPEP § 710.02(e). This requirement also applies to supplemental replies filed after the first reply.

(K) Interviews may be conducted after the expiration of the shortened statutory period for reply to a final Office action but within the 6-month statutory period for reply without the payment of an extension fee.

(L) Formal matters which are identified for the first time after a reply is made to a final Office action and which require action by applicant to correct may be required in an *Ex parte Quayle* action if the application is otherwise in condition for allowance. No extension fees would be required since the reply puts the application in condition for allowance except for the correction of formal matters — the correction of which had not yet been required by the examiner.

II. ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and, when possible, should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, the examiner may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

III. EARLY ALLOWANCE OF CLAIMS

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, the allowance of such claims should not be delayed.

Form paragraphs 7.43, 7.43.01, and 7.43.02 may be used to indicate allowable subject matter.

¶ *7.43 Objection to Claims, Allowable Subject Matter*

Claim **[1]** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

¶ *7.43.01 Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Independent Claim/Dependent Claim*

Claim **[1]** would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Examiner Note:

This form paragraph is to be used when (1) the noted independent claim(s) or (2) the noted dependent claim(s), which depend from an allowable claim, have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended to overcome the rejection.

¶ *7.43.02 Allowable Subject Matter, Claims Rejected Under 35 U.S.C. 112, Second Paragraph, Dependent Claim*

Claim **[1]** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Examiner Note:

This form paragraph is to be used only when the noted dependent claim(s), which depend from a claim that is rejected based on prior art, have been rejected solely on the basis of 35 U.S.C. 112, second paragraph, and would be allowable if amended as indicated.

¶ *7.43.04 Suggestion of Allowable Drafted Claim(s), Pro Se*

The following claim **[1]** drafted by the examiner and considered to distinguish patentably over the art of record in this application, **[2]** presented to applicant for consideration:

[3].

Examiner Note:

1. If the suggested claim is not considered to be embraced by the original oath or declaration, a supplemental oath or declaration should be required under 37 CFR 1.67.
2. In bracket 2, insert --is-- or -- are--.
3. In bracket 3, insert complete text of suggested claim(s).

Form paragraph 7.97 may be used to indicate allowance of claims.

**>

¶ *7.97 Claims Allowed*

Claim **[1]** allowed.

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707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the Office action consecutively. This facilitates their identification in the future prosecution of the application.

707.07(l) Comment on Examples

The results of the tests and examples should not normally be questioned by the examiner unless there is reasonable basis for questioning the results. If the examiner questions the results, the appropriate claims

and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., *Scarring Corp. v. Megan, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000). In *Scarring*, the original disclosure drawn to recombinant DNA molecules utilized the term "leukocyte interferon." Shortly after the filing date, a scientific committee abolished the term in favor of "IFN-(a)," since the latter term more specifically identified a particular polypeptide and since the committee found that leukocytes also produced other types of interferon. The court held that the subsequent amendment to the specification and claims substituting the term "IFN-(a)" for "leukocyte interferon" merely renamed the invention and did not constitute new matter. The claims were limited to cover only the interferon subtype coded for by the inventor's original deposits.

II. OBVIOUS ERRORS

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction. *In re Odd*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Where a foreign priority document under 35 U.S.C. 119 is of record in the U.S. application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending U.S. application. *Ex parte* *>*Bondiou*<, 132 USPQ 356 (Bd. App. 1961). This prohibition applies regardless of the language of the foreign priority documents because a claim for priority is simply a claim for the benefit of an earlier filing date for subject matter that is common to two or more applications, and does not serve to incorporate the content of the priority document in the application in which the claim for priority is made. This prohibition does not apply where the U.S. application explicitly incorporates the foreign priority document by reference. For applications filed on or after September 21, 2004, where all or a portion of the specification or drawing(s) is inadvertently omitted from the U.S. application, a claim under 37 CFR 1.55 for priority of a prior-filed foreign application that is present on the filing date of the application is considered an incorporation by reference of the prior-filed foreign application as to the inadvertently omitted portion of the specification or drawing(s), subject to the conditions and requirements of 37 CFR 1.57(a). See 37 CFR 1.57(a) and MPEP § 201.17.

Where a U.S. application as originally filed was in a non-English language and an English translation thereof was subsequently submitted pursuant to 37 CFR 1.52(d), if there is an error in the English translation, applicant may rely on the disclosure of the originally filed non-English language U.S. application to support correction of an error in the English translation document.

2163.07(a) Inherent Function, Theory, or Advantage

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

2163.07(b) Incorporation by Reference [R-3]

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed. Replacing the identified material incorporated by reference